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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,470	01/20/2006	Mark Wehner	2003DE306	9901

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EXAMINER	
SHIAO, REI TSANG	
ART UNIT	PAPER NUMBER
1626	
MAIL DATE	DELIVERY MODE
05/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/565,470	WEHNER ET AL.	
	Examiner	Art Unit	
	REI-TSANG SHIAO	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10 and 11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10 and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/20/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This application claims benefit of the foreign application:

GERMANY 103 33 042.9 with a filing date 07/21/2003.

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: the citizenship of all inventors has not been identified.

3. Amendment including cancellation of claim 9 and addition of claims 10-11 in the amendment filed on March 25, 2008 is acknowledged. Claims 1-8 and 10-11 are pending in the application. No new matter has been found. Since the newly added claims 10-11 are commensurate with the scope of the invention, claims 1-8 and 10-11 are prosecuted in the case.

Information Disclosure Statement

3. Applicant's Information Disclosure Statement filed on January 20, 2006 has been considered. Please refer to Applicant's copy of the 1449 submitted herein.

Responses to Election/Restriction

4. Applicant's election with traverse of election of Group I claims 1-8, in the reply filed on March 25, 2008 is acknowledged. The traversal is on the grounds that the outstanding Office action provided little guidance as to the breath of specieses that

would be deemed acceptable. This is found persuasive, in part, and the reasons are given *infra*.

Claims 1-8 and 10-11 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1-8 and 10-11, drawn to a processes of making compounds of formula (III).

The claims 1-8 and 10-11 herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art, see Weferling et al. CAS: 134: 42263. et al. Watanabe et al. disclose similar processes as the instant invention. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Furthermore, even if unity of invention under 37 CFR 1.475(a) is not lacking, which it is lacking, under 37 CFR 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

(1) A product and a process specially adapted for the manufacture of said product', or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

And, according to 37 CFR 1.475(c)

> if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

However, it is noted that unity of invention is considered lacking under 37 CFR 1.475(a) and (b). Therefore, since the claims are drawn to more than a product, and according to 37 CFR 1.475 (e)

> the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

The claims lack unity of invention and should be limited to only a product, or a process for the preparation, or a use of the said product. In the instant case, Groups I-II are drawn to various products, processes of making, and the final products do not contain a common technical feature or structure, and do not define a contribution over the prior art, i.e., similar processes for preparing cyclotriphosphate compounds. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

Claims 1-8 and 10-11 are prosecuted in the case. The requirement is still deemed proper.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with37 CFR 3.73(b).

Claims 1-8 and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Wehner et al. co-pending application No. 12/061,124. Although the conflicting claims are not identical, they are not patentably distinct from each other and reasons are as follows.

Applicants claim a process of making compounds of formula (III) by: (a)reacting compounds of formula (I) with acetic anhydride, (b) subsequently reactive distillation of compounds of formula (II) obtained in step (a) and conversion to compounds of formula (III) , see claim 1 or 11.

Wehner et al. '124 claim a process of making compounds of formula (III) by: (a)reacting compounds of formula (I) with acetic anhydride, (b) subsequently reactive distillation of compounds of formula (II) obtained in step (a) and conversion to compounds of formula (III).

The difference between the instant claims and Wehner et al. is that the instant invention is silent on the named condensation reaction or acylation of Wehner et al. processes. Wehner et al. processes overlap with the instant invention.

One having ordinary skill in the art would find the instant claims 1-8 and 10-11 prima facie obvious **because** one would be motivated to employ processes of Wehner et al., wherein compounds of formula (I) and acetic anhydride are starting materials. Dependent claims 2-8 and 10 are also rejected along with claim 1 under the obviousness-type double patenting.

The motivation to obtain the claimed catalyst derives from known Wehner et al. processes would possess similar yields to that which is claimed in the reference.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/REI-TSANG SHIAO /

Rei-tsang Shiao, Ph.D.
Primary Patent Examiner
Art Unit 1626

May 13, 2008